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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/020,122

Applicant(s)
Frederic J. Kirklin, et al.

Examiner
John Campa

Group Art Unit
2765

☒ Responsive to communication(s) filed on Feb 6, 1998.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 13-25 is/are rejected.

☒ Claim(s) 2-12, 26, and 27 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Feb 6, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-27 have been examined.

Allowable Subject Matter

2. Claims 1-12 and 27 would be allowable if rewritten to overcome the objections for lack of antecedent basis or any other objections or rejections set forth in this Office action.
3. Claim 26 would be allowable if rewritten to overcome any objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
5. The drawings are objected to because it is unclear how the Directing Station 32 of Figure 3 relates to the overall system, depicted in Figure 1. For example, is the Directing Station 32 part of the Central Station 10 or the Remote Station 14? If not, how does the Directing Station 32 relate to the overall system depicted in Figure 1? To dispel such ambiguities, examiner suggests either modifying the drawings to cure these issues and/or amending the specification to explain better these relationships, so long as the metes and bounds of the specification are not exceeded. Correction is required.
6. The drawings are objected to because in the specification on page 20, line 2, the description of the menu option pertaining to voice or touch tone commands is not labeled as

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“action 102,” although the action is labeled at page 20, line 6. Examiner suggests labeling the first mention of the voice/touch tone command option at line 2 to effect a clearer reading of the specification. Correction is required.

7. The drawings are objected to because of the irregularities noted on PTO 948. Appropriate correction is required.

Oath/Declaration

8. The oath or declaration is defective because it was not signed by any/all of the inventors. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 1 and 27 recite in general terms, among other limitations, a directing means that comprises a database means for storing product-related information, customer-related information order fulfillment information and product location information.

However, the specification does not disclose the directing means as including such features. Rather, the specification discloses a Central Station 10 as including a Memory (Database Records) 22 for storing product-related information, customer-related information, product location information and order fulfillment information (*see* specification, page 11, lines 4-19). Examiner has assumed for purposes of this examination that the Directing Station 32

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includes the mentioned features described as pertaining to the Central Station 10. However, examiner urges applicant to correct these discrepancies or point out any misinterpretations by examiner.

Consequently, claims 1-27 are objected to as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention since the features recited in the claims are not clearly set forth in the specification. See 37 C.F.R. § 1.75(a) and M.P.E.P. § 608.01(I).

Claim Objections

10. Claim 1 is objected to as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. See 37 C.F.R. § 1.75(a) and M.P.E.P. § 608.01(I).

Examiner has made several assumptions at this point of the examination, especially as it relates to antecedent basis, that will be clear from reading the paragraphs concerning claim objections below. These assumptions concern the examiner's suggestions of alternative claim language that appear to add a clearer understanding to the claims. These assumptions are carried through the remainder of the examination of the claimed limitations. Applicant should inform the examiner in any response to this Office action if any of these assumptions are incorrect and make appropriate changes to the claims.

Correction of the following is required:

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Claim 1, line 8 recites the limitation "said signal transmission." The limitation should be modified to recite "said wireless signal transmission" in order to have proper antecedent basis.

Claim 1, line 14 recites the limitation "said database." The limitation should be modified to recite "said database means" in order to have proper antecedent basis.

Examiner suggests reviewing the remainder of the claims not specifically mentioned for similar lack of antecedent type inconsistencies.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1, lines 18 and 24 recite the limitation "said product storage space." There is insufficient antecedent basis for this limitation in the claim.

13. Claim 17, lines 1-2 recites the limitation "wherein the step of determining additionally comprises . . ." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Examiner notes that the features recited in claim 13, lines 1-11, have been treated as merely describing the environment in which the limitations contained within the body of the claim (beginning at line 12) are to be practiced. Accordingly, the preamble of claim 13, lines 1-11, were not afforded patentable weight. A preamble generally is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hiraio*, 535 F.2d 67, 190 U.S.P.Q. 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (CCPA 1951).

16. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunte et al., U.S. Patent No. 5,873,070 in view of Helms, U.S. Patent No. 5,561,710.

As per claim 13, Bunte et al teach a portable station including:

- **interface means for interfacing to a transceiver means** (*see* column 5, lines 24-28, the headset includes a plurality of connectors for connecting PCMCIA cards having different features such as a communication link);
- **interface means for interfacing to a sound receiving means and a sound generating means** (*see* Figure 10, elements 142 and 148);
- **interface means for interfacing to a scanning means** (*see* Figure 10, element 162);

Bunte et al fails to teach:

- **translating means capable of converting digital data signals received from a scanner means into DTMF-encoded transfer signals and vice versa;**

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- transmitting the converted DTMF transfer signals to a base station.

However, Helms teaches:

- translating means capable of converting digital data signals received from a scanner means into DTMF-encoded transfer signals (*see* column 4, lines 51-68 and column 5, lines 1-9, the input received by the scanner is converted into DTMF-coded tones);

- translating means capable of re-converting DTMF-encoded transfer signals into digital data signals (*see* Figure 4, elements 52 and 60).

It would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to combine the teachings found in Bunte et al with the teachings found in Helms to get the advantage of utilizing standard telephone lines to transmit information concerning scanned items for processing by a system employing the use of DTMF codes as the communication standard.

Helms fails to explicitly teach:

- transmitting the re-converted digital data signals to the scanning means. However, it would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to modify the Helms teachings so as to send to the scanning means DTMF signals that were re-converted back into digital data signals, and to combine these teachings and obvious modifications thereto with the Bunte et al teachings to get the advantage of being able to communicate with the scanner means.

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- **transmitting the converted DTMF transfer signals to a base station.** However, it would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to modify the Helms teachings so as to transmit the converted DTMF transfer signals to a base station, and to combine these teachings and obvious modifications thereto with the Bunte et al teachings to get the advantage of making the portable station more modular and light weight since some of the components could be stored in the portable station.

As per claim 14, neither Bunte et al or Helms explicitly teach:

- **detection means for detecting DTMF-encoded signals received from the transceiver means.** However, it is deemed inherent to the Helms teachings that some type of detection means employed for detecting that DTMF-encoded signals are being sent. If the controller in Helms (*see* column 5, line 2) were not able to detect when DTMF-encoded signals were being sent to it then the system would be in operable.

As per claim 15, neither Bunte et al or Helms explicitly teach:

- **an interrupting means for preventing DTMF-encoded signals from being transferred to a sound generating means.** However, Official Notice is taken that telephonic switching means for detecting whether data or aural communications are occurring over a telephone line were old and well known in the telephonic arts at the time of applicant's invention.

It would have been obvious to one having ordinary skill in the business, computer and telephonic arts at the time of applicant's invention to combine the Bunte et al and Helms teachings and to further utilize old and well known telephonic switching means for detecting whether data

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(i.e., DTMF-encoded signals) or aural communications are occurring over the communication lines to get the advantage of preventing any DTMF-encoded signals from being sent to a user's earphones thereby preventing discomfort.

17. Claims 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al., U.S. Patent No. 5,918,213 in view of Bunte et al., U.S. Patent No. 5,873,070.

As per claim 16, Bernard et al teach a method of merchandise ordering comprising:

- **an order processing system** (*see* Figure 1, element 100);
- **identifying a customer account based upon a customer identification** (*see* Figure 32, element 3204);
- **a central station interfaced to a telephone communication network so as to be accessible to customers by telephone for creation of a merchandise order** (*see* Figures 1-8);
- **a store station linked to the central station for receiving the merchandise order from the central station** (*see* Figures 38-41);
- **selecting the merchandise order transfer characteristics for effecting the transfer to the customer of the product items of the merchandise order** (*see* column 45, lines 29-31, delivery information is determined);
- **requesting quantity and identification of product items to be added to the product order** (*see* column 59, lines 18-43, the customer browses the selections available at the retail store. If the customer comes upon an item he or she would like to purchase, the customer enters his or her

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choice at the user interface and in response, the user interface places the ordered items in the customer's order).

Examiner notes that although Bernard et al do not explicitly show requesting the quantity of the product items, it would have been obvious to one having ordinary skill in the business arts to modify the Bernard et al teachings so that the customer is asked for the quantity of the product items to be added to the product order to get the advantage of knowing how many items to prepare for the customer's order. Moreover, it is deemed inherent to the Bernard et al teachings that the system request the item quantity and identification since if this information were not specifically requested of the customer then the Bernard et al system would be inoperative in terms of being able to accept and fulfill customer's orders.

- **assembling a customer order for fulfillment** (*see* column 60, lines 9-10, the order processing center fills the customer's order).

Bernard et al fail to teach:

- **a portable station movable by a user about a product storage space.**

However, Bunte et al teach:

- **a portable station movable by a user about a product storage space** (*see* Figures 1-7).

It would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to combine the Bernard et al teachings with the teachings found in Bunte et al to get the advantage of being able to communicate instructions/directions to a user looking for a particular item in a store.

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As per claims 17 and 22, Bernard et al teach:

- providing a listing of product items contained within an unfulfilled merchandise order and inquiring whether the unfulfilled merchandise order is to be modified by checking a database (see Figure 37, elements 3732, 3736; column 50, lines 25-27, each item is reviewed one at a time, and caller selects whether to accept or delete each item). Although Bernard et al fail to explicitly teach checking a database to determine whether there are any unfulfilled orders, it is deemed inherent to the Bernard et al teachings that unfulfilled orders be stored on some type of a database, or else the Bernard et al teachings would be inoperative in terms of being able to retrieve a customer's unfulfilled orders.

As per claims 18 and 20, neither Bernard et al or Bunte et al explicitly teach:

- requesting order confirmation if a requested quantity exceeds a predetermined limit quantity and confirming the identity and quantity of items to be included in the customer order. However, Official Notice is hereby taken that it was an old and well known practice in the business arts at the time of applicant's invention to request confirmation of purchase order terms. It would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to modify the Bernard et al teachings so as to request order confirmation if a requested quantity exceeds a predetermined limit quantity and to confirm the identity and quantity of items to be included in the customer order to get the advantage of double checking a customer's purchase order to prevent errors.

As per claim 19, neither Bernard et al or Bunte et al explicitly teach:

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- **choosing between the options of delivery and pickup of the product items and picking the date and time of the transfer of the merchandise order.** However, Official Notice is hereby taken that it was an old and well known practice in the business arts at the time of applicant's invention to offer a customer options regarding whether a purchased item will be picked up or delivered and further, to have a customer pick a date and/or time merchandise is to be transferred.

It would have been obvious to one having ordinary skill in the computer and business arts at the time of applicant's invention to modify the Bernard et al teachings so as to allow the customer to choose between the options of delivery and pickup of the product items and further to allow the customer to pick the date and time of the transfer of the merchandise order to get the advantage of providing a customer with items he wishes to purchase in the manner of his choosing.

As per claim 21, Bernard et al teach:

- **determining whether the item picked from the storage space is the item transmitted to the portable station** (see column 60, lines 7-21, workers read the order information and retrieve the items from the store shelves to be provided to the customer who purchased those items).

Although the Bernard et al teachings do not explicitly show that it is determined whether the item picked from the storage space is the item transmitted to the portable station, it would have been obvious to one having ordinary skill in the business and computer arts to modify Bernard et al so as to receive item identification information at the portable station taught by Bunte et al and to

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compare that information to each product picked from the storage space to get the advantage of retrieving only those items ordered by a customer.

As per claim 23, Bernard et al teach:

- **reciting a listing of any special offer items** (*see* column 51, lines 20-28, the automated product purchasing system is provided with the capability of making special and promotional offerings to customers).

As per claim 24, Bernard et al teach:

- **requesting and recording a payment method for the cost of the merchandise order** (*see* column 61, lines 30-39, payment can be made using credit/debit/ATM or by allowing a customer to enter account information). Although Bernard et al fail to explicitly teach requesting the payment method, it is deemed inherent that a payment method for the cost of the merchandise order is requested or else the Bernard et al teachings would be inoperative in terms of being able to charge customers for products purchased.

As per claim 25, Bernard et al fail to explicitly teach:

- **transmitting a record of the merchandise order to a store station for requesting payment for the merchandise order.** However, it is deemed to be inherent to the Bernard et al teachings that some sort of merchandise order be transmitted to a store station or else the Bernard et al teachings would be unable to request payment for such an order.

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Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kipp, U.S. Patent No. 5,890,136, teaches a quick-stop mass retail system for ordering and purchasing articles from a remote location for pickup at an article pickup area at an automated store including an interactive system for communicating a customer's purchase order for at least one article, a host computer adapted for receiving the customer's purchase order, processing the customer's purchase order, storing the customer's purchase order in a database.
- Anderson, U.S. Patent No. 5,857,156, teaches a personal intercommunication purchase and fulfillment system where the system has at least one home station and at least one remote device.
- Hiroya et al., U.S. Patent No. 5,276,617, teaches a processor for determining the layout of a branch of a bank or the like and on that basis determines a moving route of a transaction processing apparatus to be moved. The transaction processing apparatus is moved to a predetermined position along the determined moving route.
- Ruppert et al., U.S. Patent No. 5,424,524, teaches a personal bar code scanning device for aiding shoppers in keeping track of their expenditures. A microprocessor coupled to a bar code reader, a communication port, an audible feedback device and a light pen carries out bar code scanning in a store as a shopper shops.

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- Walker, U.S. Patent No. Re. 35,184, teaches a remote transaction system that may be used to conduct business transactions remotely between a buyer and a seller. The system is capable of transmitting DTMF-encoded signals.
- Carrender et al., U.S. Patent No. 5,850,187, teaches a method and apparatus for object identification that includes a portable electronic tag reader having a transceiver capable of both reading identification information from electronic tags and transmitting collected information to a base unit for remote analysis. Moreover, the system uses the same transceiver to receive information from the base unit and write data to read/write electronic tags.
- LaManna et al., U.S. Patent No. 5,389,917, teaches a small and lightweight lapel data entry terminal that can be comfortably worn on a lapel of the operator's clothing and that can also be used to enter data into a remote data center. The wearer of the lapel is able to receive verbal instructions or directives from the remote data center.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Campa whose telephone number is (703) 305-1382. The examiner normally may be reached Monday-Thursday from 7:30 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, may be reached at (703) 305-9708. The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit may be submitted to (703)305-1396. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


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